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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,092	07/03/2003	Takayoshi Togino	12219/36	5806

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EXAMINER

LAVARIAS, ARNEL C

ART UNIT PAPER NUMBER

2872

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/612,092

Applicant(s)

TOGINO, TAKAYOSHI

Examiner

Arnel C. Lavarias

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 7/3/03, 1/22/04, 9/22/05, 1/12/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 2-10 and 25-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 11-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/3/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. The submission of English translations of the specification, abstract, claims, and drawings of the disclosure filed 1/22/04 is acknowledged and accepted.

### ***Election/Restrictions***

2. Applicant's election of Invention IC (Claims 11-24) in the reply filed on 1/12/06 and 9/22/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
3. Claims 2-10, 25-33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1/12/06.

### ***Priority***

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
5. The Applicant's claim for priority under 35 U.S.C. 119(a)-(d) is objected to. The instant application declares Takayoshi Togino as the sole inventor of the subject matter being claimed and additionally claims priority to prior applications JP2002-206860 filed 7/16/02 and JP2002-304555 filed 10/18/02. However, these prior applications identify

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Kokichi Kenno as the sole inventor, which is different than that of the instant application. MPEP 201.3 specifically states that to receive benefit of the filing date of a prior application filed in a foreign country, the foreign application must have been filed by the same applicant (inventor) as the applicant in the US, or by his or her legal representative or assigns.

### ***Oath/Declaration***

6. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

37 CFR 1.63-1.64 states that the oath or declaration must be made by all of the actual inventors, except as provided in 1.42, 1.43, 1.47, or 1.67. The instant application declares Takayoshi Togino as the sole inventor of the subject matter being claimed and additionally claims priority to prior applications JP2002-206860 filed 7/16/02 and JP2002-304555 filed 10/18/02. However, prior applications JP2002-206860 and JP2002-304555 identify Kokichi Kenno as the sole inventor, which is different than that of the instant application. It is unclear who the actual inventor is for the instant application.

### ***Drawings***

7. The originally filed drawings were received on 7/3/03. The replacement drawings were received on 1/22/04. These replacement drawings are acceptable.

### ***Specification***

8. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. *The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided.* The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. *It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.*

9. The abstract of the disclosure is objected to because of the following informalities:

Abstract, line 2- 'The invention relates to a' should read 'A'

Abstract, line 6- 'comprises' should read 'includes'.

Correction is required. See MPEP § 608.01(b).

10. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Examples of such errors are set forth infra.

11. The disclosure is objected to because of the following informalities:

Page 1, line 4- '7.16, 2002' should read '7/16/2002'

Page 1, line 5- '10.18, 2002' should read '10/18/2002'.

Appropriate correction is required.

### ***Claim Objections***

12. Claims 1, 11-24 are objected to because of the following informalities:

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Claim 1, line 17- 'an' should read 'a'. Claims 11-24 are dependent on Claim 1, and hence inherit the deficiencies of Claim 1.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(f) he did not himself invent the subject matter sought to be patented.

14. Claims 1, 11-24 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

The instant application declares Takayoshi Togino as the sole inventor of the subject matter being claimed, which includes the features recited in Claims 1, 11-24.

Additionally, the instant application claims priority to prior foreign applications JP2002-206860 filed 7/16/02 in Japan and JP2002-304555 filed 10/18/02 in Japan. These prior foreign applications identify Kokichi Kenno as the sole inventor, which is different than that of the instant application. Japanese publication JP2004-102204, published 4/2/04 in Japan, identifies Kokichi Kenno as its sole inventor, and similarly claims priority to prior foreign application JP2002-304555. After reviewing the JP2004-102204 publication, it appears that the drawings of the instant application are exactly the same as that of the

JP2004-102204 publication, the subject matter claimed in the instant application appear to be disclosed in the JP2004-102204 publication, and the abstract of the instant application appears to be very similar to that of the English abstract of the JP2004-102204 publication. In addition, the specification of the instant application appears to be fully disclosed by the English-equivalent specification of the JP2004-102204 publication. It is unclear who the correct inventor is of the claimed subject matter recited in the instant application. Additionally, it appears that claimed subject matter recited in the instant application may have been derived from the prior foreign applications JP2002-206860 and JP2002-304555 and the published JP2004-102204 publication.

15. Claims 1, 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Morita et al. (U.S. Patent Application Publication US2003/0133191A1).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Morita et al. discloses a projection viewing system (See Figures 1-6, 14-17), comprising at least a first display device and a second display device (See for example 1R, 1L, 1Ra, 1La in Figures 1-6; Paragraph 0032); at least a first projection optical system and a second projection optical system (See for example 1R, 1L in Figures 1-6; Paragraph 0032); a diffusing plate (See for example 5 in Figures 1-6; Paragraph 0032-

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0033, 0035); an eyepiece optical system (See for example 3 in Figures 1-6; Paragraphs 0033, 0035); wherein the first projection optical system projects an image appearing on the first display device in a first direction and the second projection optical system projects an image appearing on the second display device in a direction different from the first direction (See for example 1R, 1L in Figures 1 3-4, 14, 16-17), the diffusing plate is located near to images projected through the first and second projection optical systems (See 5, 4R, 4L in Figures 1-6), and the eyepiece optical system projects exit pupils of the first and second projection optical systems onto a viewer side (See 3, 4R, 4L in Figures 1-6). Morita et al. additionally discloses the diffusion surface being provided on at least one surface of the eyepiece optical system (See for example Figure 8); the diffusion plate comprising a transmission type hologram (See for example Paragraph 0034, 0058); and the eyepiece optical system comprising a concave mirror (See for example Paragraph 0033, 0044; Figure 9); and the concave mirror comprising a Fresnel concave reflective mirror (See for example Paragraph 0033, 0044; Figure 9).

16. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Yano (U.S. Patent No. 4078854).

Yano discloses a projection viewing system (See for example Figure 3), comprising at least a first display device and a second display device (See for example 33<sub>3</sub>, 33<sub>2</sub>, 33<sub>3</sub> in Figure 3); at least a first projection optical system and a second projection optical system (See for example 32<sub>1</sub>, 32<sub>2</sub>, 32<sub>3</sub> in Figure 3); a diffusing plate (See 21, 24 in Figures 2-3); an eyepiece optical system (See 31 in Figure 3); wherein the first projection optical system projects an image appearing on the first display device in a first direction and the



second projection optical system projects an image appearing on the second display device in a direction different from the first direction (See Figure 3), the diffusing plate is located near to images projected through the first and second projection optical systems (See 5, 4R, 4L in Figures 1-6), and the eyepiece optical system projects exit pupils of the first and second projection optical systems onto a viewer side (See for example 34<sub>1</sub>, 34<sub>2</sub>, 34<sub>3</sub>, 35<sub>1</sub>, 35<sub>2</sub> in Figure 3).

17. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Kessler et al. (U.S. Patent Application Publication (US 2002/0075452 A1).

Kessler et al. discloses a projection viewing system (See for example Figures 1-2), comprising at least a first display device and a second display device (See for example 34, 36, 38 in Figures 1-2); at least a first projection optical system and a second projection optical system (See for example 54 in Figures 1-2); a diffusing plate (See for example 32 in Figures 1-2); an eyepiece optical system (See for example 24 in Figures 1-2); wherein the first projection optical system projects an image appearing on the first display device in a first direction and the second projection optical system projects an image appearing on the second display device in a direction different from the first direction (See for example Figures 1, 8), the diffusing plate is located near to images projected through the first and second projection optical systems (See Figure 2), and the eyepiece optical system projects exit pupils of the first and second projection optical systems onto a viewer side (See 14 in Figures 1-2).

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*Conclusion*

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arnel C. Lavarias whose telephone number is 571-272-2315. The examiner can normally be reached on M-F 9:30 AM - 6 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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3/9/06